

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RYUICHIRO TAKAMOTO,
KOJI UNO, and
KAZUHIRO FUJII

Appeal 2007-1196
Application 10/711,548
Technology Center 3600

Decided: March 30, 2007

Before BRADLEY R. GARRIS, THOMAS A. WALTZ, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Primary Examiner's final rejection of claims 1-21, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 6.

According to Appellants, the invention is directed to a bicycle shift control apparatus with a canceling unit that cancels a tentative shift if the

decision unit decides that the current running condition varies from a previous running condition by a determined value (Br. 2-3). Independent claim 1 is illustrative of the invention and is reproduced below:

1. A bicycle shift control apparatus comprising:

a threshold value setting unit that sets a threshold value of a running condition for shifting a bicycle transmission;

a decision unit that decides if a current running condition value passes the threshold value;

a tentative shift unit that sets a tentative shift of the bicycle transmission when the decision unit decides that the current running condition value passes the threshold value; and

a canceling unit that cancels the tentative shift if the decision unit decides that the current running condition value varies from a previous running condition value by a determined value.

The Examiner has relied on the following reference as evidence of unpatentability:

Fujii US 2003/0071436 A1 Apr. 17, 2003

ISSUES ON APPEAL

Claims 1-21 stand rejected under 35 U.S.C. § 102(a) as anticipated by Fujii (Answer 3).

Appellants contend that Fujii never compares two sampled speeds to each other, and therefore nothing in Fujii “decides that a current running condition value varies from a previous running condition value by a determined value” as required by claim 1 on appeal (Br. 4). Appellants further contend that the tentative shift taught by Fujii is not canceled in response to a comparison of two sampled bicycle speeds to each other as

required by claim 1 on appeal, but simply because the most recently sampled bicycle speed falls below the upshift threshold value stored in a table (Br. 5). Finally, Appellants contend that the Examiner makes no mention of the claimed phrase “by a determined value,” and the decision in claim 1 on appeal must include processing based on the extent of the variation, which is not realized by Fujii (Reply Br. 2).

The Examiner contends that Fujii discloses taking two separate measurements of speed, and a decision is made on whether the current running condition value varies from a previous running condition value in order to have cancellation of the upshift (Answer 4). The Examiner contends that claim 1 on appeal mentions the cancellation of the upshift if the decision unit decides that the current running condition value varies from a previous running condition value, “meaning that only the speed only [sic] has to vary from a previous speed without comparing them” (Answer 5).

Accordingly, the issues presented in this appeal are as follows: (1) whether the claims require a decision based on the variance of a current running condition value to a previous running condition value and comparison of this variance with a “determined value”?; and (2) if so, does Fujii teach or disclose this comparison?

We determine that the Examiner has not established a *prima facie* case of anticipation in view of the reference evidence. Therefore we REVERSE the sole rejection on appeal essentially for the reasons stated in the Brief, Reply Brief, and those reasons set forth below.

OPINION

We determine the following factual findings from the record in this appeal:

(1) Fujii discloses an apparatus for controlling upshifting and downshifting of a bicycle transmission that comprises a running condition mechanism, a threshold value setting mechanism, and a control mechanism (Abstract; ¶ [0007]);

(2) Fujii additionally discloses a decision unit, a tentative shift unit, a canceling unit, and a control unit, where the current wheel speed S of the bicycle is acquired and stored, and in step S23 a decision is made whether or not the current wheel speed S is greater than the upshift threshold value U(VP) for the current speed step VP as set forth in the table of Figure 4; when the current wheel speed S exceeds the value U(VP) for the current speed step, the process moves to step S25 where a decision is made whether or not a time interval T1 has passed; if not, the wheel speed S is acquired again and a decision is made as to whether the reacquired current wheel speed S exceeds U(VP) for the current speed step (¶¶ [0029] and [0030]; Answer 3-4); and

(3) Fujii teaches that, if wheel speed S does not exceed the U(VP), the process moves to step S24 to cancel the potential upshift operation (¶ [0030]; Answer 4).

The initial burden of establishing unpatentability, on any ground, rests with the Examiner. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). A rejection for anticipation based on § 102 requires that the reference disclose, either expressly or under the principles of inherency, every limitation of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

Applying the preceding legal principles to the factual findings in the record of this appeal, we determine that the Examiner has not met the initial

burden of establishing that every limitation of the claim is disclosed by Fujii. The Examiner and Appellants agree that process of Fujii compares two measured speeds (Answer 4; Reply Br. 2; *see* factual finding (2) listed above). However, the Examiner has not shown that Fujii includes processing based on the extent of the variation in these compared speeds, i.e., cancellation of the tentative shift if the decision unit decides that the current running condition value varies from a previous running condition value “by a determined value” as required by claim 1 on appeal. We find no basis for the Examiner’s interpretation that claim 1 only means that the current speed has to vary from a previous speed “without comparing them” (Answer 5). We determine that it is clear from the claim language that the decision unit must decide if the difference in the two speeds varies by a determined value.

We note that the Examiner has stated that “the recitation that an element is ‘adapted to’ perform a function is not a positive limitation but only requires the ability to so perform” (Answer 3). However, the language of claim 1 on appeal (requiring a decision based on a comparison of the difference between the current running condition value and the previous running condition value with a “determined value”) requires a difference in programming of the decision unit of the claim that is not present in the decision unit disclosed by Fujii. Accordingly, the structure of the claimed decision unit is a modified version of the decision unit of Fujii. Therefore we determine that the Examiner has not established that each and every limitation of the claim has been disclosed by the applied reference.

For the foregoing reasons and those stated in the Brief and Reply Brief, we determine that the Examiner has not established a *prima facie* case

Appeal 2007-1196
Application 10/711,548

of anticipation in view of Fujii. Therefore we reverse the rejection on appeal.

The decision of the Examiner is reversed.

REVERSED

tf/ls

DeLand Law Office
P.O. Box 69
Klamath River, CA 96050-0069